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| EXAMINER | |
|---|---|
| ZHONG, JUN FEI | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/775,202 | CORVIN ET AL. | |
| | Examiner | Art Unit | |
| | JUN FEI ZHONG | 2426 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *13 May 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1,2,6,8,11-18,35,36,41,44-48 and 60-63* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,6,8,11-18,35,36,41,44-48 and 60-63* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *01 February 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

1. This Office Action is in response to AMENDMENTS entered 5/13/2009.

### *Status of Claims*

2. Claims 1-2, 6, 8, 11-18, 35-36, 41, 44-48, 60-63 are pending.

### *Continued Examination Under 37 CFR 1.114*

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/13/2009 has been entered.

### *Priority*

4. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119 (e) as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent

application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 60/179,548, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application.

- The provisional application fails to suggest that the "promotion is selected based upon the content of the program" as recited in claims 2 and 36;
- The provisional application fails to provide adequate support for "recording a flag with the promotion to indicate the beginning of the program during playback" as recited in claims 8 and 41;
- The provisional application fails to suggest that the "promotion is recorded at any desired point within the program" recited in claims 11 and 44;
- The provisional application fails to provide support for the particular method of distribution of the program, the promotion, and the program guide over either a "single broadcast channel" or a "plurality of broadcast channels" as recited in claims 14, 15, 46, and 47;
- The provisional application does not disclose details regarding the storage of the program, the promotion, and the program guide data with a "storage unit" or a "plurality of storage units", as recited in claims 16, 17, 48, and 62-63.

- The provisional application does not disclose details regarding the program, the promotion, and the television program guide data being received on-demand from a television distribution facility as recited in claim 60.

Accordingly, claims 2, 8, 11, 14-17, 36, 41, 44, 47-48, 60, and 62-63 do not receive the benefit of priority and are being examined on the basis of the application filling date or 01 February 2001.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 11 and 44

recites the broad recitation "any desired point within the selected program", and the claim also recites "at one of the beginning of the program or the end of the program" which is the narrower statement of the range/limitation.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1, 6, 8, 12-13, 16-18, 35, 41, 45, 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. (Patent # US 5353121) in view of Goldschmidt Iki et al. (hereinafter "Iki", Patent # US 6483987), further in view of Barton et al. (Pub # US 2001/0049820).

As to claim 35, Young discloses a system for providing an integrated recorded program/promotion playback asset (Fig. 22A, 22B), the system comprising:

a user input device (e.g., remote controller 130; Fig. 21) configured to receive a user input to select a television program to be recorded (i.e., receives record command when user press Record It Key 148) (see col. 18, lines 3-20); and

user equipment (Fig. 22A, 22B) operative to:

receive a selected program (e.g., receives television program at tuner 207);

determine whether the selected program is to be recorded (e.g., examining program titles in schedule with requested recording program title);

in response to determining whether the selected program is to be recorded (i.e., CPU 228 and/or controller 220 issues a record command):

record the selected program for inclusion in the integrated recorded program/promotion playback asset (e.g., records television program using VCR);

play back the recorded program/program playback asset in response to receiving a user indication to play back the recorded selected program (see col. 8, line 36-col. 9, line 8; col. 19, line 1-col. 20, line 13).

Young does not explicitly disclose select a promotion to record.

In an analogous art, Iki discloses selecting a promotion to record for inclusion in the integrated recorded program/promotion playback asset;

recording the selected promotion for inclusion in the integrated recorded program/promotion playback asset (see col. 8, line 59-col. 10, line 5; Fig. 5-8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have an option of recording as taught by Iki to the recording system of Young in order to provide a system automatically records television program either with or without commercials (see col. 1, lines 19-46).

Young and Iki fail to disclose the selected promotion is inserted at one of the beginning of the program or the end of the program;

In an analogous art, Barton discloses the selected promotion is inserted at one of the beginning of the recorded selected program or the end of the recorded selected program (see paragraph 0014).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have inserting the promotion as taught by Barton to the recording system of Young as modified by Iki in order to present advertisements to viewers that do not usurp the broadcaster's advertising space (see paragraph 0010).

As to claim 1, it contains the limitations of claim 35 and is analyzed as previously discussed with respect to claim 35 above.

As to claim 6, Young discloses the method of claim 1 further comprising recording both the selected program and the selected promotion on a storage unit (e.g., VCR 252; Fig. 22B).

As to claim 8, Young discloses the method of claim 7, further comprising recording a flag with the selected promotion to indicate the beginning of the selected program during playback (see col. 19, 46-61).

As to claim 12, Iki discloses the method of claim 1 further comprising receiving the selected program and the selected promotion (see col. 3, lines 3-9).

As to claim 13, Young discloses the method of claim 12 further comprising receiving program guide data (see col. 18, lines 37-55).

As to claim 16, Young discloses the method of claim 13 further comprising storing the selected program, the selected promotion, and the program guide data (see Col 18, Lines 37-55; Col 19, Line 62 – Col 20, Line 13).

As to claim 17, Young discloses the method of claim 16 wherein the selected program, the selected promotion, and the program guide data are stored on a storage unit (e.g., VCR 252; Fig. 22B).

As to claim 18, Young discloses the method of claim 16, wherein the selected program, the selected promotion, and the program guide data are stored on a plurality of storage units (e.g., RAMs 232, 234, 236, 238, 240 and VCR 252; Fig. 22B).

As to claims 41, 48, they contain the limitations of claims 8, 18 and are analyzed as previously discussed with respect to claims 8, 18 above.

As to claim 45, Young discloses the system of claim 35 further comprising a receiver that receives signals and data (Fig. 22A, 22B).

9. Claims 2, 11, 14-15, 36, 44, 46-47, 62-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. (Patent # US 5353121) in view of Goldschmidt Iki

et al. (hereinafter "Iki", Patent # US 6483987), further in view of Barton et al. (Pub # US 2001/0049820), further in view of Zigmond et al. (Patent # US 6698020).

As to claim 2, note the discussion above, Young, Iki, and Barton do not specifically disclose the selected promotion is selected based upon the content of the selected program.

Zigmond discloses the selected promotion is selected based upon the content of the selected program (see col. 12, line 60-col. 13, line 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have inserting the advertisement at any point as taught by Zigmond to the recording system of Young as modified by Iki and Barton in order to provide a means to specifically target, deliver, and present individually targeted advertisements to viewers regardless of the source of the media in order to effectively reach the consumer (see col. 3, line 45 – col. 4, line 3).

As to claim 11, Zigmond discloses the method of claim 6 wherein the selected promotion is recorded at any desired point within the selected program (see col. 14, lines 1-12; col. 16, lines 20-43).

As to claim 14, Young and Zigmond disclose the method of claim 13 wherein the selected program, the selected promotion, and the program guide data are received on

a single broadcast channel 4 (see Zigmond Col 7, Lines 1-25; Col 14, Line 66 – Col 15, Line 16)(Young et al.: Col 18, Lines 37-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have inserting the advertisement at any point as taught by Zigmond to the recording system of Young as modified by Iki and Barton and Barton in order to provide a means to specifically target, deliver, and present individually targeted advertisements to viewers regardless of the source of the media in order to effectively reach the consumer (see col. 3, line 45 – col. 4, line 3).

As to claim 15, Young and Zigmond disclose the method of claim 13 wherein the selected program, the selected promotion, and the program guide data are received on a plurality of broadcast channels (see Zigmond Col 7, Lines 1-25; Col 14, Line 66 – Col 15, Line 16)(Young et al.: Col 18, Lines 37-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have inserting the advertisement at any point as taught by Zigmond to the recording system of Young as modified by Iki and Barton and Barton in order to provide a means to specifically target, deliver, and present individually targeted advertisements to viewers regardless of the source of the media in order to effectively reach the consumer (see col. 3, line 45 – col. 4, line 3).

As to claims 36, 44, 46-47, they contain the limitations of claims 2, 11, 14-15 and are analyzed as previously discussed with respect to claims 2, 11, 14-15 above.

As to claim 62, Zigmond discloses the method of claim 1, wherein the selected promotion is inserted by accessing a storage device (e.g., advertisement repository 86) (see col. 15, lines 24-34).

As to claim 63, Zigmond discloses the system of claim 35, wherein the user equipment further comprises a storage device, wherein the storage device is accessed to insert the selected promotion (e.g., advertisement repository 86) (see col. 15, lines 24-34).

10. Claims 60-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young in view of Iki, further in view of Barton, further in view of Zigmond, and further in view of Michaud (WO 99/57904).

As to claim 60, note the discussion above, Zigmond discloses the program and the promotion are received on-demand from a television distribution facility (e.g., user requests the program and advertisement) (see col. 14, lines 25-35; col.18, lines 29-37).

Young, Iki, Barton and Zigmond fail to disclose the program guide data is received on-demand from a television distribution facility.

Michaud discloses the program guide data is received on-demand from a television distribution facility (see page 11, line27-page 13; Fig. 3).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have program data on-demand as taught by Michaud to the recording system of Young as modified by Iki, Barton and Zigmond in order to minimizing the usage of local memory in the user equipment in order to reduce the cost of the equipment (Michaud: Page 3, Lines 24 – Page 4, Line 8).

As to claim 61, Michaud discloses the system of claim 45, wherein the receiver receives signals and data on-demand from a television distribution facility (see page 11, line27-page 13; Fig. 3).

***Response to Arguments***

11. Applicant's arguments with respect to claims 1-2, 6, 8, 11-18, 35-36, 41, 44-48, 60-63 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

12. Claims 1-2, 6, 8, 11-18, 35-36, 41, 44-48, 60-63 are rejected.

***Inquiries***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUN FEI ZHONG whose telephone number is (571)270-1708. The examiner can normally be reached on M-F, 7:30~5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hirl can be reached on 571-272-3685. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JFZ
7/16/2009

/Joseph P. Hirl/
Supervisory Patent Examiner, Art Unit 2426
July 27, 2009